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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,605	04/30/2001	Akira Ichikawa	Q64273	9350

7590

09/01/2005

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EXAMINER

CHANG, VICTOR S

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/830,605

Applicant(s)

ICHIKAWA ET AL.

Examiner

Victor S. Chang

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 4-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Introduction***

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 8/15/2005. Applicants' amendments to claim 1; and new claims 8-15 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, the Examiner acknowledges that amendment to Figure 3 has been accepted in the Office action dated 3/17/2004.

### ***Rejections Based on Prior Art***

4. Claims 1, 2 and 4-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanimura et al. (US 6065701) in view of Applicants' admission, generally as set forth in section 5 of Office action dated 5-16/2005, together with the following additional reasoning and response to argument.

First, for the purpose of clarification, the Examiner repeats the relied upon prior art as follows: Tanimura's invention is directed to a label comprising electronic components (Abstract). In Fig. 2, Tanimura shows an adhesive label having an antenna wiring and an IC (electronic components) formed on a polyimide substrate 16, and an adhesive layer 17. An exfoliative paper 18 (release layer) is laminated on the adhesive

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layer 17, which is a layer of "both faces adhesive material" (i.e., double sided pressure sensitive adhesive layer) for adhering the label to a video cassette tape (column 4, lines 7-8). Tanimura also teaches a coated paper layer 12 as an outer surface layer for carrying information such as the title, recording date, and recording place of the video data recorded on a video tape (column 3, lines 52-56). It is noted that Tanimura lacks a teaching that the adhesive layer 17 is formed on a substrate surface which is in direct contact with the electronic component. However, Applicants have admitted that an adhesive label containing a contact-less data carrier element mounted on one or both surfaces of a circuit substrate, with connecting through-hole in the latter case, is conventional and well known (specification, pages 1-2, bridging paragraph).

With respect to Applicants' argument "Applicants describe in the present specification, that contactless data carrier prepared by separately forming a part of an "electric circuit," i.e., antenna coils, on each side of the circuit substrate was known. However, there is no indication that the contactless data carrier element prepared by separately forming a part of an "electronic components" on each side of the circuit substrate was known" (Remarks, page 7, second paragraph), the Examiner notes that in the absence of any specific definition, the term "electric circuit" clearly *inherently* reads on the instantly claimed "electronic components", Applicants' argument appear to be semantic, and is without merit to the present rejection.

Referring to the drawing of prior art in Fig. 3, Applicants' argument "As illustrated in Fig. 3, the entire data carrier element (2 and 21) is formed on one side of circuit substrate 1, however, adhesive layer 5 is not in direct contact with the entire data carrier

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element. Moreover, in Tanimura et al, the electronic element (antenna + IC20) is located on one side of substrate 16, and adhesive layer 17 is not in direct contact with the electronic element (Fig. 2). Accordingly ... the resulting structure would still not be the present invention, wherein the adhesive layer is in direct contact with the electronic components" (Remarks, page 7, bottom paragraph) has been carefully considered, but is not persuasive. The Examiner respectfully reminds Applicants that Applicants have admitted that a contact-less data carrier element mounted on one or both surfaces of a circuit substrate, with connecting through-hole in the latter case, is conventional and well known. In other words, clearly it is known art that a contact-less data carrier element can be formed on *either* side, or both sides, of the circuit substrate. As such, the Examiner asserts that, in the absence of unexpected results, the teachings of Tanimura in view of Applicants' admission clearly render the instant invention obvious. It should be noted that the selection of a known equivalent material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07. Also, it should be noted that claim to rearranged elements of the prior art has been held unpatentable when the rearrangement does not modify the operation of the article. See MPEP § 2144.04.VI.C.

For newly added claims 8-15, the Examiner notes that Tanimura does expressly show in Fig. 2 that adhesive layer 17 is a double sided adhesive material. Further, the Examiner repeats that, in the absence of unexpected results, the teachings of Tanimura in view of Applicants' admission clearly render the instant invention obvious, as set forth above.

***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*VSC*

Victor S Chang  
Examiner  
Art Unit 1771

8/25/2005

*Ula Ruddock*

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Primary Examiner  
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